



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,915	10/09/2003	Anthony Booth	5865-P1-03-BHJ	7682

7590 03/24/2006
Warner-Lambert Company
201 Tabor Rd
Morris Plains, NJ 07960

EXAMINER

COPPINS, JANET L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/681,915	Applicant(s) BOOTH ET AL.	
	Examiner Janet L. Coppins	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Claim 1 is pending in the instant application.

Response to Amendment

1. Applicants' Amendment of December 14, 2005, has been reviewed by the Examiner and entered in the file. Accordingly, claim 1 has been amended.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 1 previously rejected under 35 U.S.C. 103(a) as being unpatentable over Corey, E. J. et al. The Examiner notes with appreciation Applicants' amendment of claim 1 in order to delete halogen substituents on the phenyl ring. However, claim 1 remains rejected as being unpatentable over Corey, E. J. et al for the following reasons.

Applicants claim the following compound:

Claim 1 discloses a stereoscopically pure diastereomer of phenyl-methanol-pyridines, according to Formula I. These compounds are known as antagonists of histamine, useful as decongestants, bronchodilators, etc.

Determining the scope and the content of the prior art

Corey et al disclose diastereomers of phenyl-methanol-pyridines, for the enantioselective synthesis of (*S*)-carbinoxamine. The same enantiomer of the instant claimed compound is found on page 5677, with a methoxy (-O-CH₃) substitution in the 4-position. Corey et al discuss that the compounds are known as important histamine antagonists.

Art Unit: 1626

Ascertaining the differences between the prior art and the claims

The difference between the prior art and claims, if any, is that the prior art discusses the purified diastereomer in 98% ee.

Resolving the level of ordinary skill in the pertinent art

As stated previously, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art to prepare the diastereomer as instantly claimed since the prior art reference discloses the stereoisomer in 98% purity. Since R^2 , R^3 , and R^4 are floating substituents (i.e. R^2 - R^4 are not specifically attached at any fixed position), it would have been obvious to one skilled in the art to substitute any site on the phenyl ring with $-OCH_3$. Furthermore, a methoxy group attached in any position, not limited to the 4-position, would be obvious over Corey et al, since one skilled in the art would know that positional isomers have similar activity, and there would be a reasonable expectation of success. Therefore the amendments to the claim have not obviated all issues of obviousness and the Examiner maintains the rejection of the claim.

The compounds are of the same identical formula and as such would be expected to have the same utility, i.e. histamine antagonists for relieving nasal, sinus, and/or bronchial congestion. Therefore, absent a showing of unobvious and superior properties, the instant claimed diastereomer of a known compound would have been suggested to one skilled in the art.

The Examiner has also attached a second reference to the instant Office Action, an abstract of the Berova et al journal article, which also teaches the (R)-enantiomer of 4-methoxy-phenyl-2-pyridinemethanol.

Art Unit: 1626

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

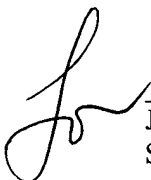
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
March 18, 2006

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



March 18, 2006



Joseph K. McKane
SPE, Art Unit 1626